

Appl. No. 10/065,970
Docket No. GEM-0066 / 126995

REMARKS / ARGUMENTS

Status of Claims

Claims 1-31 are pending in the application. Claims 1-26 stand rejected. Claims 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims. Applicant has amended Claims 5, 13, 19, 21 and 22, leaving Claims 1-31 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(b)

Claims 1-3, 9-11, 17-18, 20 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jenness et al. (U.S. Patent No. 5,373,300, hereinafter Jenness).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "*arranged as in the claim.*" *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984) (emphasis added). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

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Regarding Claims 1-3

Claim 1 recites, inter alia, "... a portion of the cable being removably disposed in and removably secured by the channel for temporarily storing the cable." (Emphasis added).

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

Contrary to the Examiner's allegation, Applicant finds Jenness to disclose a tubular member (channel) 38, and cable 21 and antenna elements 30 (cable), wherein the antenna elements 30 include antenna element 48 mounted at a fixed distance from a ground plane 44 via a radio frequency insulator 46. Column 4, lines 15-33, and Figures 1-3 (Emphasis added). As disclosed, Applicant finds cable (Jenness reference numerals 21, 30) to be disposed in a fixed relationship relative to channel (Jenness reference numeral 38) since cable 21, 30 includes antenna element 48, antenna element 48 is disclosed to be at a fixed distance from ground plane 44, and ground plane 44 is disposed on the bottom flat portion of channel 38 (see Figure 3).

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of a portion of the cable being removably disposed in and removably secured by the channel for temporarily storing the cable.

More specifically, Applicant finds Jenness to be absent any disclosure of the Jenness cable 21, 30 to be removably disposed in the Jenness channel 38, to be absent any disclosure of the Jenness cable 21, 30 to be removably secured by the Jenness channel 38, and to be absent any disclosure of the Jenness channel 38 being provided for temporarily storing the Jenness cable 21, 30, and the Examiner has not stated with specificity where Jenness does provide such disclosure of the claimed elements *arranged as claimed*.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness simply cannot be anticipatory.

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Dependent claims inherit all of the limitations of the parent claim.

Regarding Claims 9-11

Claim 9 recites, inter alia, "... contact surfaces integral to the housing configured to releasably secure the portion extending from the housing to the housing."

Here, the "portion" has antecedent basis in Claim 9 as being the "portion" of the cable extending from the housing. Thus, the cable portion extending from the housing is claimed to be releasably secured to the housing by contact surfaces integral to the housing.

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of contact surfaces integral to the housing configured to releasably secure the portion extending from the housing to the housing, and the Examiner has not stated with specificity where Jenness does provide such disclosure of the claimed elements *arranged as claimed*.

Contrary to the claimed invention, Applicant finds Jenness to disclose a channel 38 that *fixes* the cable 21, 30 to the housing 12, via *contact adhesive* 42 (Column 4, lines 15-33, and Figures 1-3), which is substantially different from the claimed invention having contact surfaces integral to the housing configured to releasably secure the portion extending from the housing to the housing.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness simply cannot be anticipatory.

Dependent claims inherit all of the limitations of the parent claim.

Regarding Claims 17-18

Claim 17 recites,

"A method of storing a cable in a monitoring device, the method comprising:
extending a cable to reduce an outside diameter of the cable to less than a width

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of a channel formed in the monitoring device;

disposing the extended cable in the channel; and

releasing the extended cable to secure the cable within the channel."

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including *all* of the aforementioned method limitations. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of *a method of storing a cable* in a monitoring device *according to the claimed invention*, where each and every element of the claimed invention must be considered.

More specifically, Applicant finds Jenness to be absent any disclosure of *extending a cable to reduce an outside diameter of the cable to less than a width of a channel formed in the monitoring device*, to be absent any disclosure of *disposing the extended cable* in the channel, and to be absent any disclosure of *releasing the extended cable to secure the cable within the channel*, and the Examiner has not stated with specificity where each and every element of the claimed invention may be found in Jenness.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness simply cannot be anticipatory.

Dependent claims inherit all of the limitations of the parent claim.

Regarding Claim 20

Claim 20 recites, inter alia,

"...a portion of the cable being *removably disposed* in the channel."

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

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In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of a portion of the cable being removably disposed in the channel, and the Examiner has not stated with specificity where such disclosure may be found in Jenness.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness simply cannot be anticipatory.

Dependent claims inherit all of the limitations of the parent claim.

Regarding Claim 26

Claim 26 recites, inter alia,

"...the cable being removably received in the channel."

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of the cable being removably received in the channel, and the Examiner has not stated with specificity where such disclosure may be found in Jenness.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness simply cannot be anticipatory.

In summary, the Examiner alleges anticipation, but has not shown with specificity where Jenness discloses the following elements arranged as claimed:

"... a portion of the cable being removably disposed in and removably secured by the channel for temporarily storing the cable." (Claim 1).

"... contact surfaces integral to the housing configured to releasably secure the portion extending from the housing to the housing." (Claim 9).

"A method of storing a cable in a monitoring device, the method comprising:
extending a cable to reduce an outside diameter of the cable to less than a width of a channel formed in the monitoring device;

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disposing *the extended cable* in the channel; and
releasing the extended cable to secure the cable within the channel." (Claim 17).

"...a portion of the cable being *removably disposed* in the channel." (Claim 20).

"...the cable being *removably received* in the channel." (Claim 26).

Dependent claims inherit all of the limitations of the parent claim.

In view of the absence of a showing of each and every element arranged as claimed, Applicant respectfully submits that the Examiner has not properly met the burden of a showing of anticipation.

In view of the foregoing remarks, Applicant submits that Jenness does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 4-8, 12-16, 19 and 21-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jenness in view of Doherty et al. (U.S. Patent No. 6,567,277, hereinafter Doherty).

The Examiner alleges that Jenness discloses some elements of the claimed subject matter as set forth above under the 35 U.S.C. §102 rejections, acknowledges that Jenness is deficient in disclosing other elements of the claimed subject matter, and looks to Doherty to cure these deficiencies. Paper No. 0304, page 3.

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5

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U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Under this obviousness rejection, the Examiner acknowledges that Jenness is deficient, and alleges that Doherty discloses:

"... wherein the cable has *a relaxed outside diameter and a stretched outside diameter*, the relaxed outside diameter being *greater than a width of the channel* and the stretched outside diameter *being less than the width of the channel*... wherein the cable is received in the channel in *press-fit* fashion... further comprising: *a detent formed on a side of the channel*, the detent *releasably retaining* the cable in the channel." Paper 0304, pages 3-4. (Emphasis added).

Applicant respectfully disagrees that such deficiencies are cured.

While the Examiner alleges that Doherty discloses a cable with *a relaxed outside diameter and a stretched outside diameter*, the relaxed outside diameter being *greater than a width of the channel* and the stretched outside diameter *being less than the width of the channel* (paper 0304, page 3) (emphasis added), the Examiner does not recite where in Doherty such a disclosure may be found, and Applicant finds no such disclosure in Doherty.

Contrary to the Examiner's allegation, Applicant finds Doherty to teach a cable 16 having *a single relaxed outside diameter* (Figures 1, 2 and 6), and being absent the attribute of having *a relaxed outside diameter greater than a width of the channel 26 and a stretched outside diameter less than the width of the channel 26*. In Doherty, the cable 16 is taught to be wrapped around the channel 26 and secured to the housing 11 by a flexible member 40. Column 3, lines 1-5, and Figure 6. Not only does Applicant find Doherty deficient in teaching *a relaxed outside diameter greater than a width of the channel and a stretched outside diameter less than the width of the channel*, but Applicant also finds Doherty to be deficient in teaching a stretched outside diameter *and* a relaxed outside diameter in and of itself.

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While the Examiner alleges that Doherty discloses the cable being received in the channel in *press-fit* fashion (paper 0304, page 3) (emphasis added), the Examiner does not recite where in Doherty such a disclosure may be found, and Applicant finds no such disclosure in Doherty.

Contrary to the Examiner's allegation, Applicant finds Doherty to teach the cable 16 being wrapped around the channel 26 and secured to the housing 11 by a flexible member 40. Column 3, lines 1-5, and Figure 6. Not only does Applicant find Doherty deficient in teaching the cable being received in the channel in a *press-fit* fashion, but Applicant also finds Doherty to be teaching just the opposite, namely, securement of the cable by the addition of an auxiliary member (flexible member 40), and not securement of the cable by the absence of an auxiliary member utilizing a press-fit arrangement.

While the Examiner alleges that Doherty discloses *a detent formed on a side of the channel*, the detent *releasably retaining* the cable in the channel (paper 0304, page 4) (emphasis added), the Examiner does not recite where in Doherty such a disclosure may be found, and Applicant finds no such disclosure in Doherty.

Contrary to the Examiner's allegation, Applicant finds Doherty to teach the cable 16 being wrapped around the channel 26 and secured to the housing 11 by a flexible member 40. Column 3, lines 1-5, and Figure 6. Not only does Applicant find Doherty deficient in teaching *a detent formed on a side of the channel*, the detent *releasably retaining* the cable in the channel, but Applicant also finds Doherty to be teaching just the opposite, namely, securement of the cable by the addition of an auxiliary member (flexible member 40), and not securement of the cable by the absence of an auxiliary member utilizing a detent formed on a side of the channel.

In contrast to the present invention, Applicant submits that a Doherty flexible member 40 used for securing a Doherty cable 16 in a *wrapped configuration* (Figure 6) is not a disclosure of a cable being *removably disposed in and removably secured by the channel* for temporarily storing the cable, as claimed, that Jenness also fails to disclose this element, and that Doherty fails to cure this deficiency of Jenness.

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Regarding Claims 5, 13, 19 and 22 Specifically

Applicant has amended Claims 5, 13, 19 and 22 to now include the limitation of the cable being coiled *in the form of a spring*. No new matter has been added as antecedent support may be found in the specification as originally filed at Paragraph [0016].

In view of the amendment and foregoing remarks, Applicant submits that Jenness and Doherty are absent any disclosure, teaching or suggestion of the cable being coiled *in the form of a spring*.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

Regarding Allowable Subject Matter

Claims 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims.

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Claims 27-31 depend from Claim 26, and in view of the foregoing remarks, Applicant submits that Claim 26 is allowable, that Claims 27-31 are therefore also allowable as being dependent upon an allowable claim, and respectfully requests notice of allowance thereof.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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